REMARKS

The present paper constitutes the "submission" required by 37 CFR §1.114(c) in connection with the Request for Continued Examination being filed simultaneously herewith. Specifically, the present paper sets forth new arguments in traverse of the sole ground of rejection applied in the Official Action of January 28, 2003, with 37 CFR §1.114(c) listing such "new arguments" as one of the recognized types of submissions sufficient to support the filing of an RCE.

The arguments and supporting evidence set forth in applicants' previous responses of April 28, 2003 and May 28, 2003 will not be repeated herein. Applicants nevertheless note that both such previous responses were entered and are of record, and applicants maintain the positions taken in those responses. The new arguments set forth herein are therefore supplemental to the arguments made previously.

As the Examiner will recall, the sole issue remaining to be resolved in the present application is the rejection of all pending claims under 35 USC §112, first paragraph, based on the allegation that the change in units from m^{-3} to cm^{-3} constituted an impermissible introduction of "new matter" into the present application, this despite that neither the outstanding Official Action nor the subsequently issued Advisory Action has provided any rationale or supporting evidence in support of that allegation, as it is

the Patent Office's burden to do.

The Examiner will also recall that the units in question appear correctly as cm^{-3} in the Japanese priority application No. 2000-085198 of March 24, 2000, as the Examiner can verify from the certified copy thereof filed in this application on April 10, 2001. Therefore, the obvious error as to the units in question appearing in the U.S. specification as filed indisputably arose from a mere translator's or typographical error when preparing the present specification from the Japanese priority application. The issue presented by the present application is therefore similar in significant respects to that presented by the case of *In re Oda*, 443 F.2d 1200, 170 USPQ 260 (CCPA 1971), wherein the correction of an inadvertent translator's error in the U.S. application as filed was held not to constitute new matter when the disclosure appeared correctly in the foreign priority application, and given that a skilled artisan would have recognized that the disclosure in the U.S. application as filed was mistaken and further would have known what it should have been, as is unquestionably the case herein.

However, in addition to and apart from the unrebutted evidence of record establishing the propriety of the amendment in question, applicants furthermore note that the amendment was proper because the Japanese priority application must be regarded as having been incorporated by

reference into the present specification, at least to the extent of supporting the amendment to correct the expression of units from the obviously incorrect m^{-3} to the obviously correct cm^{-3}.

Specifically, the present application as filed included as a part thereof a Utility Application Transmittal Letter that identified this application as "**corresponding to** Japanese application 2000-085198, filed March 24, 2000…". See Utility Application Transmittal Letter, p.1 (emphasis added).

A literal reading of the obviously incorrect m^{-3} units would result in the above statement being untrue. Specifically, the concentration ranges associated with those units would then be six orders of magnitude lower than the same numerical ranges described in the foreign priority application. Plainly, such a reading would cause the present application not to correspond to the Japanese application whose priority is claimed.

As the Official Action provides no rationale whatsoever in support of the purported "new matter" rejection, it furthermore provides no basis to support accepting as correct the obviously incorrect aspect of the present disclosure, while disregarding altogether the disclosure that the present application corresponds to the Japanese priority application, a statement as to which there is no basis for doubt.

Thus, the Utility Application Transmittal Letter forming a part of the application papers as filed provides a further and independent basis requiring withdrawal of the new matter rejection. As regards the law and procedure concerning incorporation by reference, the Examiner's attention is directed to MPEP §608.01(p). There is no fixed incantation required to incorporate by reference from a foreign priority application; to the contrary, the Courts have held that the Commissioner has considerable discretion in determining what may or may not be incorporated by reference in a patent application. See *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). The facts of the present application clearly recommend an exercise of that discretion in favor of a finding that the Japanese priority application was effectively incorporated by reference into the present application, at least to the extent supporting correction of the obviously incorrect m^{-3} units to the obviously correct cm^{-3} units.

To be sure, essential material cannot be incorporated by reference to a foreign application, and hence the incorporation by reference presented by the present application was an "improper" incorporation by reference. The point is procedural rather than substantive, however, because an "improper" incorporation by reference can be cured by bodily insertion of the essential material so incorporated,

without loss of priority. See the *In re Hawkins* cases appearing at 179 USPQ 157, 163 and 167 (CCPA 1973). This is precisely what was done by the amendment filed November 4, 2002 in the present application.

Therefore, in addition to and independent of the previously submitted and unrebutted argumentation and evidence supporting the propriety of the units correction in question, the amendment of November 4, 2002 correcting the units in question should be viewed not as introducing new matter into the present application, but rather as curing an otherwise improper by reference to the Japanese priority application.

Withdrawal of the new matter rejection is therefore believed further to be required in view of the above new arguments. As this is the only outstanding issue to be resolved, withdrawal of that rejection will place this application in condition for allowance with the pending claims 1, 4-11, 13-22 and 25-55. Allowance and passage to issue of the present application on that basis are accordingly respectfully requested.

Respectfully submitted,

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